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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,108	03/19/2001	Venkata A. Bhagavatula	SP00-095	9668
22928	7590	09/02/2005		
CORNING INCORPORATED			EXAMINER	
SP-TI-3-1			PRASAD, CHANDRIKA	
CORNING, NY 14831			ART UNIT	PAPER NUMBER
			2839	
DATE MAILED: 09/02/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/812,108	BHAGAVATULA ET AL.	
	Examiner	Art Unit	
	Chandrika Prasad	2839	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 18-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 18-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8/17/05</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after allowance or after an Office action under *Ex Parte Quayle*, 25 USPQ 74, 453 O.G. 213 (Comm'r Pat. 1935). Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 8/19/05 has been entered.

Claim Objections

2. Claims 4, 21, 24, 28 and 49 are objected to because of the following informalities: "weight" should be changed to -- mole -- to be consistent with the specification. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 22, 25, 35-36, and 46 are rejected under 35 U.S.C. 102(b) as being anticipated by Seiji (JP 54066152).

Seiji (Figures 1-6) shows an optical waveguide lens comprising an optical waveguide 13 and a lens member 10 with a spherical lens portion 11 and a throat

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portion 12 having a cross-sectional dimension greater than that of the optical waveguide. The waveguide has a core and a cladding is inherent. Seiji further shows a ferrule with a bore for receiving the waveguide. Seiji further teaches a method of making the lens and used in a passive, active optical components such as switch component or router, multiplexer, demultiplexer, etc.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-13, 18-21, 23-24, 26-34, 41, 47-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Seiji (JP 54066152).

Seiji shows all the features of these claims except the material of the lens member and the core of the waveguide, and dimensions of the waveguide. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to make the lens member of 4 weight percent borosilicate, having a softening point less than that of the core of the waveguide of various sizes, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. In re Leshin, 125 USPQ 416. Furthermore, a mere change in the size of a component is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

7. Claims 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lebduska (4078852).

Lebduska shows a first, a second and a third waveguide with spherical lenses disposed on three faces of a birefringent material wherein the a throat portion of the lens has a diameter greater than the diameter of the waveguide but does not show two waveguides disposed on the same face. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to provide such a feature since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japiske, 86 USPQ 70.

8. Claims 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lebduska (4078852).

Lebduska shows all the features of these claims except the material of the lens member and the core of the waveguide. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to make the lens of borosilicate glass material with a softening point less than that of the core of the waveguide, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use. In re Leshin, 125 USPQ 416.

9. Claims 42-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Konno et al. (5293438) in view of Lynch et al. (4844580).

Konno shows a waveguide attached to a lens member with a throat having a cross-section dimension greater than that of the wave guide but does not show another similar waveguide connected to the throat. Lynch shows two similar waveguides spaced

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apart , each with a lens member with a throat portion. It would have been obvious to one of ordinary skill in the art at the time of the instant invention to attach a second waveguide because this would require a mere duplication of essential parts, which involve only routine skill in the art as shown by Lynch. St. Regis Co. vs. Bemis co., 193 USPQ 8.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. JP 57-186722 and JP 64-50003.

Contact Information

11 Any correspondence to this action may be mailed to:

**Commissioner for Patents
Post Office Box 1450
Alexandria, VA 22313-1450**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chandrika Prasad whose telephone number is (571) 272-2099.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor can be reached at (571) 272-2800 ext 39. The fax number is (703) 872-9306.



Chandrika Prasad
Primary examiner
August 26, 2005